

#### **DETAILED ACTION**

Applicants response filed 03/20/2008 is acknowledged.

Applicants amended the claims.

Claim 1 is pending.

See interview summary.

The previously examined claim was drawn to compounds (product claims).

The instantly amended claim is drawn to product by process.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The previously presented rejection of claim 1 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, is maintained.

The present amendments overcome part of the previously presented rejections, the claim remains vague and indefinite.

The depiction of chemical formulae with the names over and below the structure is inconsistent for the three formulae and thus it is unclear which General Formula corresponds to which structure.

The newly added definitions are further confusing. *For example*, new neighboring substituents on the benzene ring are defined capable of forming rings. It is unclear what rings are formed when mono-

Art Unit: 1625

valent substituents such as halogens, hydroxy, cyano etc can be substituents and at the same time form additional rings.

While the bonding of the chromenone to para-positions with respect to the nitrogen is defined (and is consistent with the nature of the invention), it is not pictured correspondingly in the claimed formula (assuming the first formula corresponds to the compounds claimed).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The previously presented rejection of claim 1 under 35 U.S.C. 112, first paragraph, is maintained for reasons of record.

The inclusion in the amended claim, the process elements in the claim overcome part of the previously presented rejections. The working examples and direction and guidance remain limited in the amended claims. The direction is limited to Buchwald type reaction for the formation of the crucial aryl-N bond. Primary and secondary amine substituents in the final product, *for example*, would be incompatible with the direction, guidance disclosed in the specification for making the compounds. Thus amendments to claims overcome part of the rejection pertaining to the making part of the invention.

The breadth of the amended claims remains wide and is not supported by the disclosure in the specification. Applicant is non-responsive to the unpredictability issue with regards to the optical properties of all the claimed variables, raised in the previous office action page 5, lines 10-13.

Genentech Inc. v. Novo Nordisk A/S (CA FC) 42 USPQ2d 1001, states that "a patent is not a hunting license. It is not a reward for search, but compensation for its successful conclusion" and "[p]atent protection is granted in return for an enabling disclosure of an invention, not for vague intimations of general ideas that may or may not be workable".

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The previously presented rejection of claim 1 under 35 U.S.C. 103(a) as being unpatentable over Bader et al. and Yoshio et al. is maintained for reasons of record.

Product by process claims are still product claims. It is not relevant how the product is made and as such whether Bader or Yoshio teach the process steps is not relevant.

The reaction cited on page 24 of Applicants Remarks does not relate to the obviousness rejection.

.Applicants argument did not overcome the previously presented rejection. Further, Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NIZAL S. CHANDRAKUMAR whose telephone number is (571)272-6202. The examiner can normally be reached on 8.30 AM - 4.30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on 571 0272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nizal S. Chandrakumar

/D. Margaret Seaman/  
Primary Examiner, Art Unit 1625